

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Christoph BENDER

Application No.: 10/658,404

Filing Date: 10 September 2003

For: Production System for the Manufacture of
Products

Art Unit: 2125

Examiner: Jarrett, Ryan A.

Attorney Ref. No.: 003-077

Via Fax: 703.746.4000

COMMENTS ON EXAMINER'S STATEMENT OF REASONS FOR ALLOWANCE**Mail Stop ISSUE FEE**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant gratefully acknowledges the Notices of Allowance and Allowability dated 18 August 2004 for the above-captioned patent application. An Examiner's Statement of Reasons for Allowance was appended to the Notice of Allowability. Applicant has the following comments.

While the claimed combinations are patentable over the prior art for the reasons presented therein, the claimed combinations are patentable for many more reasons. More specifically, the patentability of the claimed combinations is not limited to the particular subset of features identified in the Statement, but rather it is the entire combinations of elements and/or steps in the claims, each taken as a whole, that are patentable over the prior art, both taken alone and in hypothetical combination. Furthermore, the claimed combinations are allowable over all of the prior art, and not merely the subset identified in the Statement as "[t]he prior art obtained by the examiner."

Att'y Ref. No. 003-077

U.S. App. No.: 10/658,404

If additional fees are necessary to prevent abandonment of this application, then the Commissioner is authorized to charge my Deposit Account No. 50-2821.

Respectfully submitted,

By: 

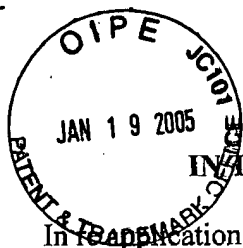
Adam J. Cermak
Registration No. 40,391

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Alexandria, Virginia 22307

703.768.0994

Date: 15 November 2004

[Page 2 of 2]



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Examiner: Jarrett, Ryan A.

Attorney Ref. No.: 003-077

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REQUEST FOR CORRECTED NOTICE OF ALLOWABILITY**Mail Stop ISSUE FEE**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant gratefully acknowledges the Notices of Allowance and Allowability dated 18 August 2004 for the above-captioned patent application. At page 2 of the Notice of Allowability, the Information Disclosure Statement (IDS) filed 5 November 2003 ("November 5th IDS") was objected to, and the four documents cited therein were not considered. Applicant respectfully requests reconsideration of this objection, full consideration of the documents cited in the November 5th IDS, and return to Applicant of a copy of the examiner-initialed PTO-1449. To assist the examiner, a duplicate copy of the PTO-1449 from the November 5th IDS is enclosed herewith.

The objection alleged that the November 5th IDS "does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 C.F.R. 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language." Because the November 5th IDS did in fact include a submission which, according to current U.S. practice as reflected in the Manual of Patent Examining Procedure (M.P.E.P.), satisfied 37 C.F.R. § 1.98(a)(3), the objection to the November 5th IDS is in error.

The November 5th IDS included a copy of a search report issued in German application number 102 41 742.3 (dated 15 April 2003); this search report was also listed on the PTO-1449. The November 5th IDS, at page 3 thereof, item 5, indicated that "The document(s) was/were

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cited in a corresponding foreign application. ☒ A copy of a search report issued in the foreign application is attached. . . . M.P.E.P. § 609(A)(3)." A review of the search report indicates that, in fact, the three German patent documents cited on the PTO-1449 were cited in the search report (see page 1, bottom). Adjacent to each of the citations in the German search report appears the letter "X".

M.P.E.P. § 609 III (A)(3) states, in discussing submissions that may satisfy the requirements of 37 C.F.R. § 1.98(a)(3), in part:

Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. *This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.* The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

(emphasis added). Thus, the indication of an "X", "Y", or "A" (in this case, "X") on the German search report adjacent to each of the documents cited in the search report satisfies the requirements of 37 C.F.R. §§ 1.56(c), 1.98(a)(3).

Accordingly, the November 5th IDS fully complied with 37 C.F.R. § 1.98(a)(3), as permitted by M.P.E.P. § 609 III (A)(3). The objection to the November 5th IDS was therefore in error, and should be withdrawn. Full consideration of the documents cited in the November 5th IDS, correction of the record to reflect their consideration, and return to Applicant of a copy of the examiner-initialed PTO-1449, is respectfully requested.

[Page 2 of 3]

Att'y Ref. No. 003-077

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Respectfully submitted,

By: 

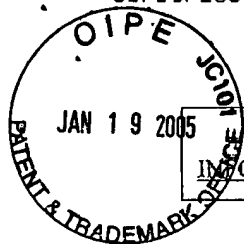
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[Page 3 of 3]



Page 1 of 1

FORM PTO 1449 INFORMATION DISCLOSURE STATEMENT	ATTY. DKT. NO.: 003-077	APP. NO.: 10/658,404
	APPLICANT(S): Christoph BENDER	
	FILING DATE: 10 Sept. 2003	Group Art Unit: 2125

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	PUB'N DATE	NAME	CLASS	SUB- CLASS	FILING DATE

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION
	198 40 801 A1	16 Mar. 2000	DE			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
	100 62 471 A1	4 July 2002	DE			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
	100 17 378 A1	18 Oct. 2001	DE			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
						<input type="checkbox"/> Yes <input type="checkbox"/> No
						<input type="checkbox"/> Yes <input type="checkbox"/> No

OTHER (Including Author, Title, Date, Pertinent Pages, Publisher, etc.)

Search Report from DE 102 41 742.3 (15 April 2003)

EXAMINER	DATE CONSIDERED
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.	